JUN 08 2006

Attorney Docket No. BLFR 1002-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Group Art Unit: 3623
Robert E. DVORAK et al.	
Application No.: 09/755,355	Examiner: Beth Van Doren
Confirmation No.: 3933	
Filed: 05 January 2001	**CUSTOMER NO. 22470**
Title: **METHOD AND APPARATUS FOR SUPPLYING SYNTHETIC SALES HISTORIES**	

MAIL STOP PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER THE 37 CFR § 1.144 TO BE DECIDED BY
TECHNOLOGY CENTER GROUP DIRECTOR
REGARDING IMPROPER RESTRICTION REQUIREMENT

Sir:

Applicants petition under 37 C.F.R. § 1.144 from the restriction requirement

made final by the Examiner in the identified examination on April 5, 2006. Pursuant to

MPEP § 1002.02(c)(2), this Petition is to be decided by the Technology Center Director.

Restatement of the Claims begins on page 2.

Remarks begin on page 7.

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The Claims:

The following is a list of claims pending in this application and their current status. This listing is provided because this petition addresses a restriction requirement.

1.   (Original) A computer implemented method of supplying a sales history for a good lacking a sales history, including:

associating sales history data for sales of a cloned good at a plurality of selling locations with an other good;

scaling the associated sales history data upward or downward based on anticipated sales of the other good;

tracking actual sales of the other good for an interval; and

rescaling the associated sales history data based on actual sales of the other good during the interval.

2.   (Original) The method of claim 1, wherein the rescaling takes place after the interval without intervention of a user.

3.   (Previously presented) The method of claim 1, wherein the rescaling takes place repeatedly on a predetermined cycle beginning at the end of the interval, without intervention of a user.

4.   (Original) The method of claim 1, wherein associating sales history data includes copying the sales history data.

5.   (Original) The method of claim 2, wherein associating sales history data includes copying the sales history data.

6.   (Original) The method of claim 1, wherein associating sales history data includes creating a reference to the sales history data.

7.   (Original) The method of claim 2, wherein associating sales history data includes creating a pointer to the sales history data.

8.   (Original) The method of claim 1, wherein scaling the associated sales history data includes modifying the associated sales history data.

9.   (Original) The method of claim 2, wherein scaling the associated sales history data includes modifying the associated sales history data.

10.   (Original) The method of claim 1, wherein scaling the associated sales history data includes storing a scaling factor to be applied to the associated sales history data.

11.   (Original) The method of claim 2, wherein scaling the associated sales history data includes storing a scaling factor to be applied to the associated sales history data.

12.   (Original) The method of claim 1, wherein rescaling the associated sales history data includes modifying the associated sales history data.

13.   (Original) The method of claim 2, wherein rescaling the associated sales history data includes modifying the associated sales history data.

14.   (Original) The method of claim 1, wherein rescaling the associated sales history data includes storing a scaling factor to be applied to the associated sales history data.

15.   (Original) The method of claim 2, wherein rescaling the associated sales history data includes storing a scaling factor to be applied to the associated sales history data.

16.   (Withdrawn) A computer implemented method of supplying a sales history for a selling location lacking a sales history, including:

associating sales history data for sales of a plurality of goods at a cloned selling location with an other selling location;

scaling the associated sales history data upward or downward based on anticipated sales at the other selling location;

tracking actual sales of the goods at the other selling location for an interval; and

rescaling the associated sales history data based on actual sales of the goods at the other selling location during the interval.

17.   (Withdrawn) The method of claim 16, wherein the rescaling takes place after the interval without intervention of a user.

18.   (Withdrawn) The method of claim 16, wherein the rescaling takes place repeatedly on a predetermined cycle begin at the end of the interval, without intervention of a user.

19.   (Withdrawn) The method of claim 16, wherein associating sales history data includes copying the sales history data.

20.   (Withdrawn) The method of claim 17, wherein associating sales history data includes copying the sales history data.

21.   (Withdrawn) The method of claim 16, wherein associating sales history data includes creating a reference to the sales history data.

22.   (Withdrawn) The method of claim 17, wherein associating sales history data includes creating a pointer to the sales history data.

23.   (Withdrawn) The method of claim 16, wherein scaling the associated sales history data includes modifying the associated sales history data.

24.   (Withdrawn) The method of claim 17, wherein scaling the associated sales history data includes modifying the associated sales history data.

25.   (Withdrawn) The method of claim 16, wherein scaling the associated sales history data includes storing a scaling factor applicable to the associated sales history data.

26.   (Withdrawn) The method of claim 17, wherein scaling the associated sales history data includes storing a scaling factor applicable to the associated sales history data.

27.   (Withdrawn) The method of claim 16, wherein rescaling the associated sales history data includes modifying the associated sales history data.

28.   (Withdrawn) The method of claim 27, wherein rescaling is based on actual sales of the other selling location as a whole.

29.   (Withdrawn) The method of claim 27, wherein rescaling is based on actual sales of the respective goods at the other selling location.

30.   (Withdrawn) The method of claim 17, wherein rescaling the associated sales history data includes modifying the associated sales history data.

31.   (Withdrawn) The method of claim 30, wherein rescaling is based on actual sales of the other selling location as a whole.

32.   (Withdrawn) The method of claim 30, wherein rescaling is based on actual sales of the respective goods at the other selling location.

33.   (Withdrawn) The method of claim 16, wherein rescaling the associated sales history data includes storing one or more scaling factors applicable to the associated sales history data.

34.   (Withdrawn) The method of claim 33, wherein rescaling is based on actual sales of the other selling location as a whole.

35.   (Withdrawn) The method of claim 33, wherein rescaling is based on actual sales of the respective goods at the other selling location.

36.   (Withdrawn) The method of claim 17, wherein rescaling the associated sales history data includes storing one or more scaling factors applicable to the associated sales history data.

37.   (Withdrawn) The method of claim 36, wherein rescaling is based on actual sales of the other selling location as a whole.

38.   (Withdrawn) The method of claim 36, wherein rescaling is based on actual sales of the respective goods at the other selling location.

39.   (Previously presented) A computer implemented method of supplying a sales history for a good lacking a sales history, including:

associating sales history data for sales of a cloned good at a plurality of selling locations with an other good;

scaling the associated sales history data upward or downward based on anticipated sales of the other good;

tracking actual sales of the other good for an interval; and

comparing the actual sales of the other good to the sales history data for a set of candidate goods and evaluating whether the sales history of one or more of the candidate goods better matches said actual sales than the associated sales history data of the cloned good.

40.   (Original) The method of claim 39, wherein the actual sales interval includes a plurality of causal periods and evaluating takes place on a causal period by causal period basis.

41.   (Original) The method of claim 39, wherein the actual sales interval includes daily or more frequent periods and evaluating takes place on a daily or more frequent period basis.

42.   (Original) The method of claim 39, wherein comparing and evaluating take place after the actual sales interval, without intervention of a user.

STATEMENT OF FACTS

This application was originally filed in United States with an effective filing date of January 5, 2001. It was assigned to Examiner Beth Van Doren, who has been very courteous in interviews with the lead inventor by telephone and with counsel in person.

On December 10, 2004, the Examiner mailed the first Office Action in this application, wherein claims 1, 4, 8, 10, 12, 14, 16, 19, 23, 25, 27-29, 33-35 and 39-40 were rejected under 35 U.S.C. 102(a) as being anticipated by Technology Strategy, Inc. web pages "A", "B" and "C" (www.grossprofit.com) (collectively "TSI"). In addition, claims 2-3, 5-7, 9, 11, 13, 15, 17-18, 20-22, 24, 26, 30-32 and 36-38 were also rejected under 35 U.S.C. 103(a) as being unpatentable over TSI in view of Lee et al. (U.S. 5,712,985). Lastly, claims 41-42 were also rejected under 35 U.S.C. 103(a) as being unpatentable over TSI. The rejections of independent claim 1 and dependent claims 2-15 were paralleled by the rejections of independent claim 16 and dependent claims 17-27, 30, 33 and 36. There was no difference in the Examiner's wording of grounds for the parallel rejections.

All claims were searched prior to the first office action.

Applicants filed their response on May 26, 2005.

On October 24, 2005, the Examiner withdrew the initial grounds of rejection and mailed a restriction requirement. She proposed two groups: Group I (claims 1-15 and 39-42, directed to supplying sales history to a good that lacks a sales history by associating the sales data of another good); and Group II (claims 16-38, directed to supplying a sales history to a selling location by associating sales history from a cloned location).

There is substantial overlap between independent claims 1 and 16, which lead Groups I and II, and among the claims that depend from them.

1. A computer implemented method of supplying a sales history for a good lacking a sales history, including:	16. A computer implemented method of supplying a sales history for a <u>selling location</u> lacking a sales history, including:
associating sales history data for sales of a cloned good at a plurality of	associating sales history data for sales of a <u>plurality of goods at a cloned selling</u>

selling locations with an other good;	location with an other selling location;
scaling the associated sales history data upward or downward based on anticipated sales of the other good;	scaling the associated sales history data upward or downward based on anticipated sales at the other selling location;
tracking actual sales of the other good for an interval; and	tracking actual sales of the goods at the other selling location for an interval; and
rescaling the associated sales history data based on actual sales of the other good during the interval.	rescaling the associated sales history data based on actual sales of the goods at the other selling location during the interval.

Additional overlap appears between claims depending from 1 and 16. The similarity table shows that nearly all of the claims depending from claim 16 are similar to claims depending from claim 1; only dependent claims 28 and 29 introduce elements that are not found in the claims depending from claim 1. Conversely, *all* of the claims that depend from claim 1 find similar claims depending from claim 16.

From claim 16:	Similar to:
17	2
18	3
19,20	4-5
21,22	6-7
23,24	8-9
25,26,33,36	10-11
27,30	12-15
28,31,34,37	new
29,32,35,38	new

The rationale accompanying the October 24, 2005 restriction requirement was based on combinations and sub combinations. The Examiner cited MPEP 806.05(d), stating that the inventions of Group I and Group II are distinct from each other and are related as subcombinations disclosed as usable together in a single combination. Particularly, the Examiner argued that Group I has a separate utility such as supplying sales history to a good that lacks a sales history, such as a new good being introduced to market, and Group II has separate utility such as opening a new store and supplying sales data to this new store since it is without a sales history. The Examiner refers to Applicants' response filed on May 26, 2005, wherein Claim 1 and Claim 16 are compared to each other.

On January 24, 2006, Applicants elected Group I and traversed the grounds for restriction.

On April 5, 2006, the Examiner mailed an office action that made final the restriction requirement. This petition timely follows.

ISSUE ON PETITION

Whether it was an error to impose a restriction requirement between independent claims 1 and 16, lacking any assertion of two-way distinctness and in the absence of any serious burden for searching?

REASONS WHY RESTRICTION IS IMPROPER AND SHOULD BE OVERRULED BY THE TECHNOLOGY CENTER DIRECTOR

Patterns in the Related Cases

The two-way restriction between independent claims 1 and 16 is improper for the reasons given in traversal and in related cases. While it is tempting to say that 42 claims (three independent claims) can be examined as two groups, this is one of six related applications before the same Examiner, five of which have been restricted into 21 groups, so far, which is too many. Many of the restrictions followed a search covering all claims and a rejection based on a primary reference that applied to all of the claims and all of the groups later designated. In the six related applications, the first art reference that the Examiner selected (TSI) was the basis for rejecting all of the claims in three different patent applications (and might have been applied in the other cases, except that it had been withdrawn already.) The second art reference that the Examiner selected (Landvater) was the basis for rejecting the elected claims in four different patent applications. The third art reference that the Examiner selected (Crosswhite) was part of the basis for rejections in the two cases that did not cite Landvater.

Applicants have approached the Examiner and the Group Director with a proposal for voluntary representative examination, along the lines that have been proposed by the Office for general purposes. This application is suitable for representative examination, because there is substantial overlap between independent claims 1 and 16 and between the claims that depend from them, which could be

handled by selecting a dozen claims including the three independent claims as representative of the 42 claims. Some of the other applications are more dramatic candidates for representative examination, for reasons explained when voluntary representative examination was proposed.

This is not to say that limited restriction practice might not be appropriate in some of the related cases. We recognize, as a practical matter, the pressures for productivity that face examiners and the consequences of restrictions for productivity scoring. In this case, however, the restriction imposed after searching all of the claims was inappropriate.

Errors and Prejudice in this Case

The Examiner erred when she failed to apply the MPEP restriction criteria revised in August, 2005. The Examiner further erred when she failed to reconsider the restriction requirement under the revised criteria when they were brought to her attention.

The Examiner's errors prejudice Applicants and impair the efficiency of the PTO. Applicants are prejudiced by piecemeal examination and by a doubling both the number of office actions to which they must respond and the number of fees that they must pay for issue, maintenance, etc. Applicants already paid extra fees to have this Examiner search all 42 claims and received a rejection of all 42 claims founded on a single primary reference. Applicants are accordingly critical of any claim that searching the 42 claims would impose a serious burden on the Examiner. The efficiency of the PTO is impaired by the Examiner's solicitation of a divisional application. (Some responsibility for the number of continuation cases being processed by the PTO, which the Commission for Patents blames for backlog, rests with the incentives created for examiners to impose restriction requirements.)

Limits on Discretion to Restrict

The Examiner relied on an outdated version of the MPEP in the restriction requirement and, arguably, the wrong sub paragraph of § 806.05.

The new revision of the MPEP, published August 2005, is much clearer on the limits to an Examiner's discretion to impose restriction requirements than was the prior MPEP. In particular, §§ 802 *et seq.* set standards that the Examiner may not have been

aware of, as they were not referenced in the Examiner's restriction rationale or subsequent office action.

802.01 Meaning of "Independent" and "Distinct" [R-3]

II. < DISTINCT

**>Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Examples of related inventions include< combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. **>In< this definition the term related is used as an alternative for dependent in referring to *>inventions< other than independent *>inventions<.

>Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at **least one invention is PATENTABLE** (novel and nonobvious) **OVER THE OTHER** (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (**combination and subcombination**) and § 806.05(j) (related products or related processes) for examples of when a **two-way test is required for distinctness**.<

803 Restriction — When Proper [R-3]

Under the statute>, the claims of< an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § **>802.01, § 806.06, and § 808.01<) or distinct (MPEP § 806.05 - § *>806.05(j)<). If the search and examination of **>all the claims in an< application can be made **without serious burden**, the examiner **must** examine *>them< on the merits, even though **>they include< claims to independent or distinct inventions. >

I. < CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § *>806.06<, § 808.01) or distinct as claimed (see MPEP § 806.05 - § *>806.05(j)<); and (B) There *>would< be a **serious burden** on the examiner if restriction is >not< required (see MPEP § 803.02, **>§ 808<, and § 808.02).

* * *

For purposes of the initial requirement, a **serious burden** on the examiner may be *prima facie* shown ** by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be **rebutted by appropriate showings** or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § *>806.04< - § 806.04(i) and § 808.01(a).

<p align="center">* * *</p>

806.05(c) Criteria of Distinctness *> Between< Combination *>and< Subcombination ** [R-3]

**

To support a requirement for restriction >between combination and subcombination inventions<, **both two-way distinctness and reasons for insisting on restriction** are necessary, i.e., >there would be a **serious search burden** as evidenced by< separate classification, status, or field of search. See MPEP § 808.02.

<p align="center">* * *</p>

**>

I. SUBCOMBINATION ESSENTIAL TO COMBINATION

AB_{sp}/B_{sp} No Restriction

Where a combination as claimed sets forth the details of the subcombination as separately claimed, **there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility.** This situation can be diagrammed as combination AB_{sp} ("sp" is an abbreviation for "specific"), and subcombination B_{sp}. Thus the specific characteristics required by the subcombination claim B_{sp} are also required by the combination claim.

<p align="center">* * *</p>

806.05(d) Subcombinations Usable Together [R-3]

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually **>restrictable **when the subcombinations do not overlap in scope** and are not obvious variants<.

(the "**" notations are from the MPEP text; the "* * *" notations are added to indicate omitted sections). The final section, "subcombination essential to combination" was added in the August, 2005 revision.

The revised restriction criteria were timely raised with the Examiner.

The Examiner's Rationale Did Not Satisfy MPEP Version 8 Revision 3/4

The Examiner's starting point was that the claims are only distinct (not independent) and are related as combinations and subcombinations. The Examiner's analysis of combinations and subcombinations did not address the newly added text of §§ 803, 806.05(c) and (d), reproduced above. Instead of addressing the required two-way distinctness standard, from double patenting precedent, and the requirement for the subcombinations not to overlap in scope/serious searching burden, the Examiner applied only a separately usable test. The new MPEP revision clearly requires two-way distinctness and lack of overlap in scope for restriction of subcombinations. "Separately usable" is no longer enough.

The Examiner did not make a *prima facie* case of two-way distinctness, as measured by the new MPEP guidance. The Examiner did not apply the two-way distinctness requirement even after it was raised. The two-way distinctness requirement applies to both § 806.05(c) and (d). Subsections (c) and (j) are examples of when the two-way test is required. §§ 802.01 & 806.05. Subsection (d) does not fit into the exception from two-way distinctness that is provided for inventions in different statutory categories (*id.*), such as apparatus and method. Because the Examiner did not make a *prima facie* case of two-way distinctness or even attempt to do so, the restriction requirement should be overruled.

Further, the new MPEP emphasizes that the Examiner must prove that a serious burden would result if restriction were not required, even if the Examiner establishes independence or distinctness, regardless of which subsection of 806.05 is invoked. §§ 803, 806.05(c). In § 806.05(d), the serious burden test is restated in a requirement that the subcombinations considered for restriction must "not overlap in scope." *See form paragraph 8.16.* Distinctness is not enough.

The Examiner has twice argued that the "search required for Group I is not required for Group II." One time she said this was because the claims were distinct and

the other time because of differing subject matter. Applicants submit that these perfunctory and conclusory recitals do not satisfy the MPEP and that Applicants have proven that there is no serious burden to searching Group I while searching Group II.

One criterion for search burden is whether the same class and subclass are involved. Here, the restriction requirement identifies class 705, subclass 10 as applicable to all of the claims, claims 1-42. This weighs against restriction.

The similarity between claims 1-15 and 16-38 evidences overlap in the searches. None of the dependent claims 2-15 lack a counterpart in claims 17-38. That is, searching Group II would entail a search of the dependent claims 2-15. Conversely, searching Group I would be required to properly search Group II. Between the independent claims 1 & 16, it is difficult to imagine (and the Examiner has given no example of) a reference that would read on claim 30 (depending from claim 16) without also reading on claim 1.

The Examiner's prior search of all claims belies the argument that there would be a serious burden, as the search has already been done.

The Examiner's experience in this case, applying the TSI reference to all claims 1-42, before restriction, is telling. Comparing pp. 2-3 with p. 4 of the office action mailed December 10, 2004, the grounds for rejection claim 1 based on TSI were *cut and pasted verbatim* into the grounds for rejection of claim 16. Not only was the same search applied to both claims, the same words were used by the Examiner in the rejectons.

The Examiner's experience across six related cases is compelling. Just three references have been the touchstone for two rounds of rejections in six cases!!! There is so much efficiency in handling the cases together that one or two searches are serving the purpose for six applications, with or without restriction.

As a separate and independent reason for finding the restriction requirement to be in error, Applicants urge that the Examiner has not proven that a serious burden would result if restriction were not required. Because the search and examination of all claims in the application can be made without serious burden, the MPEP directs that the examiner must examine them on the merits, without restriction. § 803.

Accordingly, for lack of two-way distinctness and lack of serious search burden, the restriction should be overruled.

Renewed Proposal

Applicants renew their proposal for the Director to support a pilot voluntary representative examination approach to this application and the five related applications. The real burden is not in searching, but in restating the grounds of rejection many times for the many similar dependent claims. With the chart provided, that burden has already been reduced. From the chart, the practicality of representative examination should be apparent.

CONCLUSION

Applicant respectfully submits that the restriction requirement should be overruled, as suggested above.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,

Dated: 5 June 2006

Ernest J. Beffel, Jr.
Registration No. 43,489

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EVIDENCE APPENDIX
(see PAIR/PALM for the relevant office actions)

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with
the U.S. Postal Service for First-Class mail delivery, postage prepaid,
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P.O. Box 1450, Alexandria, VA 22313-1450 on 5 June 2006.
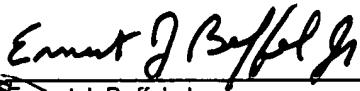
Ernest J Beffel Jr
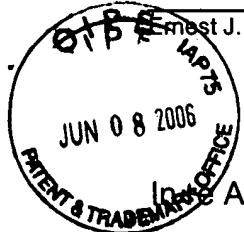
Ernest J. Beffel, Jr.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Group Art Unit: 3623
Robert E. DVORAK et al.	
Application No.: 09/755,355	Examiner: Beth Van Doren
Confirmation No.: 3933	
Filed: 05 January 2001	**CUSTOMER NO. 22470**
Title: **METHOD AND APPARATUS FOR SUPPLYING SYNTHETIC SALES HISTORIES**	

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF PETITION UNDER 37 CFR 1.144

Sir:

In connection with the above-referenced U.S. patent application, transmitted herewith are/is the following paper(s):

[X]   **Petition Under 37 CFR 1.144 To Be Decided by Technology Center Director Regarding Improper Two-Way Restriction Requirement Among 42 Claims**; and

[X]   **Check No. 3741** in the amount of $130 in payment of the filing fee for the above-identified Petition.

The Commissioner is hereby authorized to charge any underpayment of fees, or credit any overpayment, to our Deposit Account No. 50-0869 (Attorney Docket No. BLFR 1002-1).

Respectfully submitted,

Dated: 5 June 2006

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